Claims 8-22 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. **35 U.S.C. § 103, Obviousness**

The Examiner rejected Claims 8-22 under 35 U.S.C. § 103 as being unpatentable over Young et al. (US Patent No. 5,532,754 in view of Emura (US Patent No. 6,344,878). This rejection is respectfully traversed.

The present claimed invention is directed to the automatic reservation (scheduling) of a recorder for the recording of repetitively transmitted programs, in which the programs can conflict in the times of transmission. The claims expressly recite a means or a step of grouping programs that interfere (conflict) with each other in time, and a means or step for assigning a *recording priority* to (1) each group, and (2) to each program within a group, such that all of the programs are efficiently recorded in sequence by the recorder.

Specifically with respect to Claim 8, Applicants show that none of the cited references teach or suggest the claimed feature of (1) "grouping means for grouping the *reserved data broadcast programs* into one or more groups in which each group contains programs that interfere with each other with respect to recording by the reception and recording means" (emphasis added) or (2) "priority assigning means for assigning a unique recording priority to each group and to each program within a group such that all of the reserved repeating programs can be recorded in sequence according to the assigned priorities" (emphasis added). These claimed features advantageously provide the ability *to record the reserved programs in sequence according to the assigned priority, notwithstanding the fact that the programs can overlap in time.*

In rejecting Claim 8, the Examiner cites Young Col. 16/lines 39-58 and Col. 26/lines 15-49 as reading on the claimed grouping means, and cites Young Col. 8/lines 9-34 and Col. 16/lines 39-58 as reading on the claimed priority assigning means. The Examiner then states that Emra teaches a technique of handling overlapping programs to

a same recording media using reservation means, scheduling and priority as noted earlier. Applicants show error in the Examiner's rejection, as follows.

With respect to the claimed grouping means (missing claimed feature #1), the Young passage cited at Col. 16/lines 39-58 is directed to grouping of a program listing guide that is displayed to a user. As stated by Young at the passage cited by the Examiner at Col 16:

> "Another embodiment employs <u>channel customization prompt menus to re-arrange channels</u>. In this approach, each channel label is <u>sequentially displayed</u> over time in a default sequence (such as numeric/alphabetic sequence, or according to the previously selected user-sequence). The channels are preferably <u>displayed</u> one at a time. The viewer can select a priority for each channel as it is <u>displayed</u> or can skip to the next channel label. If a priority is given, the channel will be moved into the channel slot corresponding to the entered priority, as if it were selected and moved into that slot as discussed above. The priorities that may be assigned range from 1 to 9, the highest number on the numeric keypad (in some embodiments 0 is used to represent 10). Note that the total number of channels that can be re-arranged is not limited to the number of priorities (9). For example, the user could assign the same priority (such as number 1) to as many channel labels as desired. The last selected channel label would then appear in the number 1 slot, with the remainder immediately following below, according to the order in which they were selected."

As stated by Young at the passage cited by the Examiner at Col 26:

> "It is desirable to list programs in the order of most favorite channels instead of sequentially by channel number or alphabetically as in a printed television guide. A channel menu is provided to allow the viewer to arrange channel listings in the preferred order. In this way, the most favorite channels will be grouped together, on one or two pages, greatly reducing the need to perform channel paging. This is usually a one-time installation menu that allows the user to define channels that are favorites, and to be <u>listed in the grid guide</u> in a preferred order.
>
> The channel select menu provides a list of all channels that can be received by a viewer. From this list, channels can be designated as favorites. Favorite channels are automatically given certain priorities. For example, in the event that the schedule memory is insufficient to store all the listing information downloaded from broadcast, program notes and other descriptive information for non-favorite channels will be discarded before discarding such information for favorite channels. In case of severe

shortage of memory space, listings for non-favorite channels will be discarded first.

The channel select menu also allows the viewer to decide on the listing priority of favorite channels on the grid guide. In one implementation, the channel select menu is a list of all channels, arranged in columns. The first column on the left, from top to bottom, will be the order in which channel listings will appear in the grid guide. Once favorite channels are designated, they will automatically be grouped together in the left-most columns. For example, if there are four favorite channels, such as CNN, DISN, HBO and SHO, it is possible to position SHO as the first channel in the grid guide. To do this, highlight the location where the new channel is to be moved. In this case, CNN is first highlighted. Next select the preferred channel, SHO. When this is done, CNN, DISN, and HBO will shift down one slot, and SHO will be entered into the first slot."

As can be seen, these cited passages are directed to a technique for customization of a listing of channels (e.g. grid guide) on a display. This customization of the grid guide listing is also shown by Young's FIG. 20. The groups as described by Young are a favorite channel group which is displayed in a particular area on the screen for access by a user. In contrast, Claim 8 recites a grouping means for grouping "the reserved data broadcast programs", which are defined in Claim 8 to be data broadcast programs for which *reservation requests* have been accepted. Young's customized grid guide cannot reasonably be construed as a teaching of grouping reserved data broadcast programs, as claimed.

As to the claimed priority assignment means (missing feature #2), Applicants show that the passage cited by the Examiner at Young Col. 8/lines 9-34 and Col. 16/lines 39-58 pertains to a link list (Col. 8) and channel priority (Col. 16). Applicants urge that a user specifying what order to list channels in a channel grid display has nothing to do with the claimed recording priority. Young's channel grid priority merely prioritizes the order that the channels are displayed to a user, and has nothing to do with recording. Hence, such channel display priority as taught by Young does not teach the claimed recording priority which, per the plain meaning of the term, is a priority with respect to recording.

It is further shown that missing claimed feature #2 recites two types of recording priority assignments – a recording priority for each group (the group containing programs that interfere with each other with respect to recording) and a recording priority to each

program within a group. Neither the Young reference nor the Emura reference teach or otherwise suggest such hierarchical recording priority assignment. While Emura teaches a technique for dealing with overlapping programs and their recording, the technique as disclosed by Emura is different from that claimed in Claim 8. Emura does not contemplate any type of hierarchical priority assignment, where a unique priority assignment is assigned to both the group and programs within a group. Thus, Claim 8 is still further shown to not be obvious in view of the cited references.

In summary with respect to Claim 8 (and dependent Claims 9-11), none of the cited references teach the claimed grouping of interfering programs, and then assigning a unique recording priority to both (1) each group, and (2) to each program within a group, such that all of the reserved repeating programs can be recording in sequence according to the assigned priorities. Thus, a prima facie case of obviousness has not been established with respect to Claim 8[1].

Applicants traverse the rejection of Claims 9-11 for reasons given above with respect to Claim 8 (of which Claims 9-11 depend upon).

Applicants traverse the rejection of Claim 12 for similar reasons to those given above with respect to Claim 8, and show that none of the cited references teach or suggest the claimed grouping or the assigning of a unique receiving priority to both the group(s) and to each program within a group.

Applicants traverse the rejection of Claim 13 (and dependent Claims 14-16) for similar reasons to those given above regarding Claim 12.

Applicants traverse the rejection of Claim 17 (and dependent Claims 18-20) for similar reasons to those given above regarding Claim 12.

Applicants traverse the rejection of Claim 21 (and dependent Claim 22) for similar reasons to those given above regarding Claim 12.

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[1] In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. Id. To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Further with respect to Claim 22, Applicants urge that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed feature of overriding, by a user, one or more of the assigned recording priorities. Thus, Claim 22 is further shown to have been erroneously rejected as a prima facie case of obviousness is further shown to have not been established by the Examiner.

Therefore, the rejection of Claims 8-22 under 35 U.S.C. § 103 has been overcome.

II.   Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: __11/23/04__

Respectfully submitted,

Duke W. Yee
Reg. No. 34,285
Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorneys for Applicants